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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,212	11/12/2003	Michael E. Connell	2269-5083.1US (01-0428.01)	6326
24247	7590	08/08/2007	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			LANDAU, MATTHEW C	
			ART UNIT	PAPER NUMBER
			2815	
			MAIL DATE	DELIVERY MODE
			08/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,212	Applicant(s) CONNELL ET AL.	
	Examiner Matthew C. Landau	Art Unit 2815	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,10-14,16-20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,10-14,16-20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>5/29/2007</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 29, 2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 10, this claim depends from cancelled claim 9, rendering the claim indefinite. For the purposes of the below art rejection, it is considered that claim 10 was intended to depend from claim 7.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-8, 10-14, 16-20, and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Sakaki et al. (US PGPub 2003/0017652, hereinafter Sakaki).

Regarding claims 1, 7, 13 and 19, Figure 3 of Sakaki discloses a semiconductor die comprising: a semiconductor substrate 1 having a front side 1B and a back side 1A; a low ratio of height to horizontal dimension (see fig. 2), tensile stresses, and compressive stresses; an integrated circuit on a portion of the front side (note that the front side is also labeled 1X which is designated the "circuit formation surface"); a passivation layer 7 (resin, para. [0096]) covering a portion of the integrated circuit causing a stress on at least a portion of the substrate; and a stress-balancing layer 2 covering at least a portion of the backside substantially balancing the stress caused by the passivation layer covering a portion of the integrated circuit (see paras. [0106] and [0107], esp. [0107] at the third sentence, which teach that layer 7 causes a stress which is compensated by layer 2), the stress or force balancing layer comprising a temporary adhesive material (paragraph 127, layer 2 is thermally adhered to substrate 1). Additionally, whether or not the adhesive is temporary or permanent is merely a matter of the intended use, which does not structurally distinguish the claimed invention over the prior art. Note that Sakaki teaches layer 7 applies a compressive stress (by contraction) to the substrate (paragraph [0106]). A compressive stress in a first direction (e.g., vertical) creates a tensile stress in a direction perpendicular to the first direction (e.g., horizontal). Therefore, the substrate has both compressive and tensile stresses.

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Regarding claims 2, 4, 8, 10, 14, 16, 20 and 22, Sakaki teaches that the balancing layer 2 is a resin, which may be considered either a single component layer or a homogenous mixture of a strong material. The limitations “sensitive to an optical energy altering the material by at least one of heating...” and “for laser-marking” are merely recitations of intended use that do not structurally distinguish the claimed invention over the prior art. The balancing layer is capable of being modified (marked) by laser beam.

Regarding claims 5, 6, 11, 12, 17, 18, 23 and 24, Sakaki teach in figure 9 an adhesive layer 41A attached to the stress-balancing layer 2 (para. 0136). The limitations “sensitive to an optical energy altering the material by at least one of heating...” and “for laser-marking” are merely recitations of intended use that do not structurally distinguish the claimed invention over the prior art. The adhesive material is capable of being modified (marked) by laser beam.

Response to Arguments

Applicant's arguments filed May 29, 2007 regarding the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Note that in the response filed May 5, 2006, Applicant argued that Sakaki et al. was not available as prior art under 102(e) because the publication date was after the effective filing date of the instant application. However, this argument is not persuasive. Sakaki et al. is a continuation of application # 09/493,279, which was filed on January 28, 2000. Therefore, the effective U.S. filing date of Sakaki et al. is 1/28/200, which predates the effective filing date of the instant application (2/25/2002). See MPEP section 901.02, which states: “Additionally, as

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described in MPEP § 901.03, a patent application publication published under 35 U.S.C. 122(b) of an application that has become abandoned may be available as prior art under 35 U.S.C. 102(e) as of the earliest effective U.S. filing date of the published application”.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew C. Landau whose telephone number is 571-272-1731. The examiner can normally be reached on 9:00AM - 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ken Parker can be reached on 571-272-2298. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Matthew C. Landau
Primary Examiner
Art Unit 2815

8/3/07